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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/689,230	10/20/2003	David A. Ebert	60,137-222; 350-3315-U	4065

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EXAMINER

ESTREMSKY, GARY WAYNE

ART UNIT	PAPER NUMBER
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3676

DATE MAILED: 03/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/689,230

Applicant(s)

EBERT, DAVID A.

Examiner

Gary Estremsky

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12/21/04.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Pat. No. 5,797,422 to Tokarz.

Tokarz '422 teaches Applicant's claim limitations for a lever including : a "shank" - including 20, a "handle" - including 22, where the written Background of the Invention indicates that decorative materials including porcelain or clear plastic (inherent fragility well known) are used for the handle portion where one of ordinary skill in the art recognizes that shank portion is likely to be chrome-plated brass for example.

As regards claim 5, see Fig 4 for example.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 5,797,422 to Tokarz.

While Tokarz '422 does not explicitly disclose a "crystal material" for example, the handle material is explicitly disclosed to be "Decorative" where one of ordinary skill in the art recognizes that "crystal" glass, or quartz crystal, jade, etc. handles would be decorative and useable with respect to the teachings of Tokarz '422. One of ordinary skill in the art would have found it obvious at the time of the invention to use a "crystal material" for the handle 22 of Tokarz '422 to appeal to various buyer market groups. One of ordinary skill in the art would have more than a reasonable expectation of success since the proposed modification would not otherwise affect function of the device but is entirely consistent with the explicit and implicit teachings of the reference. It has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

5. Claims 3, 4, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 5,797,422 to Tokarz in view of U.S. Pat. No. 2,105,617 to Shaw.

While the arrangement at 46,48 of Tokarz '422 might be assumed to be a single piece, head of the bolt, Shaw '617 teaches that it is well known in the art to provide a separate cap (41) to cover a bolt used to attach a handle. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide a separate cap for covering the bolt of Tokarz '422, as modified to ensure that no aesthetically unwanted

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screw slots, etc are visible. One of ordinary skill in the art would have more than a reasonable expectation of success in making the proposed modification.

As regards claim 4, a cross section through the handle at 40 (42 in Fig 4) fully anticipates limitation especially noting that a cross-section in that area will be perpendicular to the handle's axis whereby due to inherent geometry, the area of the 'donut' shape cross section of the handle will be considerably more than twice the area of the circle-shaped bore.

As regards claim 10, Shaw '617, as relied upon specifically teaches threads on the cap member for threaded attachment to the bolt whereby the handle is held in compression. It's noted that embodiment of Tokarz '422 relied upon as base reference also teaches a bolt holding the handle in compression whereby one of ordinary skill in the art would have more than a reasonable expectation of success in making the proposed modification.

6. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 5,797,422 to Tokarz in view of U.S. Pat. No. 1,829,365 to Meyer.

Although Tokarz '422 discloses a "shallow pocket" in the shank for receiving the handle portion, it is not particularly clear if there is an angle to that portion or not whereby it is not clear that "frusto-conical" limitation is taught. However, Meyer '365 discloses a similar shank/handle structure and explicitly illustrates a frusto-conical shallow pocket in the shank for receiving a correspondingly-shaped handle portion in Fig 1. It would have been an obvious design choice or engineering expedient to one of

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ordinary skill in the art to provide the handle/shank of Tokarz '422 with a frusto-conical shaped shallow pocket as taught by Meyer '365 in order to reduce any minor wobbliness resulting from manufacturing tolerances where it is well known in the art that a tapered connection is more tolerant of tolerances.

7. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 5,797,422 to Tokarz in view of U.S. Pat. No. 1,829,365 to Meyer and further in view of U.S. Pat. No. 2,105,617 to Shaw.

While the arrangement at 46,48 of Tokarz '422 (as modified in view of Meyer '365) might be assumed to be a single piece, head of the bolt, Shaw '617 teaches that it is well known in the art to provide a separate cap (41) to cover a bolt used to attach a handle. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide a separate cap for covering the bolt of Tokarz '422, as modified to ensure that no aesthetically unwanted screw slots, etc are visible. One of ordinary skill in the art would have more than a reasonable expectation of success in making the proposed modification.

8. Claims 8, 9, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 5,797,422 to Tokarz in view U.S. Pat. No. 2,105,617 to Shaw and further in view of U.S. Pat. No. 1,829,365 to Meyer .

While the arrangement at 46,48 of Tokarz '422 might be assumed to be a single piece, head of the bolt, Shaw '617 teaches that it is well known in the art to provide a

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separate cap (41) to cover a bolt used to attach a handle. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide a separate cap for covering the bolt of Tokarz '422, as modified to ensure that no aesthetically unwanted screw slots, etc are visible. One of ordinary skill in the art would have more than a reasonable expectation of success in making the proposed modification. And while the cap of Shaw '617 is shown to have an angled handle-contacting surface defining a frusto-conical shaped surface, and is shown to contact a wall portion of the handle, it is not clear that the handle's contacting surface is angled. However, it would have been obvious to one of ordinary skill in the art in full consideration of the three references (relied upon) to provide the handle, shank, and cap of Tokarz '422, as modified in view of Shaw '617 with corresponding *angled* surfaces defining a frusto-conical shape as taught by Meyer '365 (where handle 13 engages in shallow pocket of part 12) for the purpose of taking up tolerance as well known to one of ordinary skill in the art.

Response to Arguments

Applicant's arguments have been considered but are not entirely persuasive. Arguments related to intended use of the handle with a door are not persuasive. Applicant argues that the door is referred to in the body of the claim are noted but it is only referred to *functionally* as part of some *intended use* and not positively recited as part of the invention. See MPEP 2114. The invention is a product, defined by its structure. Case law is clear; the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus

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satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

It is the examiner's position that the structure of the prior art is inherently capable of use with a door. However, it is not reasonable or necessary to consider whether or not it would be obvious for someone to actually use it with a door since combination with a door is not claimed as the invention. If Prosecution were Continued and the claims amended to include the shank being attached to a door at one end, obviousness under 35 USC 103 would be considered.

Applicant's arguments that the hole of Tokarz '422 appears "large" are speculative and generally contrary to what is shown. Inasmuch as the diameter of the hole is shown to be less than a third of the handle's diameter at its narrowest part, it is clear to one knowledgeable in geometry that the cross-sectional area ($\pi \times \text{radius squared}$) of the hole is considerably less than a half of the area of the portion of the handle that abuts the end face of the shank (i.e., the right end of the handle as it is shown in Fig 2 or Fig 7, or left end as shown in Fig 4).

Arguments that Tokarz '422 doesn't teach "fragile" are not persuasive where claims do not include "fragile", and "fragile" is a relative, if not vague material description. Reference to the above grounds of rejection as to how limitations of the claims are interpreted is suggested.

Applicant's argument as to lack of specific suggestion of "crystal" are not persuasive where the prior art suggests use of decorative material and Applicant admits that use of crystal is well known, case law provides that within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended

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use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. See MPEP 2144.04 (Legal Precedent as Source of Supporting Rationale, and Aesthetic Design Changes), 2144.06 (Art Recognized Equivalence), and 2144.07 (Art Recognized Suitability for an Intended Purpose). In that respect, a prior art reference does not have to provide an exhaustive list of materials that might be used to attain the stated objectives (features) in order to provide implicit suggestion for use of well known materials having the properties required to attain the stated objectives (features). Otherwise, it's noted that had the reference provided explicit suggestion to use "Crystal", the rejection would have been made under 35 USC 102.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary Estremsky whose telephone number is 703 308-0494. The examiner can normally be reached on M-Thur 7:30-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Will can be reached on 703 308-3870. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Gary Estremsky
Primary Examiner
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